

REMARKS/ARGUMENTS

In the Office Action dated July 2, 2007, claims 7-8 and 13-14 are objected under 37 C.F.R. §1.75 as being a substantial duplicate of claims 10-11 and 16-17.

Claims 1-2 and 4-6 are provisionally rejected for nonstatutory obviousness-type double patenting over claims 5-6 and 9-11 of copending Application No. 10/471,087.

Claims 10-11 and 16-17 are rejected under 35 U.S.C. §112, second paragraph, for indefiniteness, and under 35 U.S.C. §101 as improper process claims.

Claims 1 and 7-11 are rejected under 35 U.S.C. §102(b) as being anticipated by JP06-009359 (the '359 patent).

Claims 1, 3 and 7-11 are rejected under 35 U.S.C. §102(e) as being anticipated by US6,416,573 (the '573 patent).

Claims 2, 4, 12 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by CA2,374,539 (the '539 patent).

Claims 1, 3 and 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '573 patent in view of JP11-130652 (the '652 patent).

In response to the Office Action and to ensure that the claim language conforms to the U.S. patent practice, Applicants have amended claims 1, 2, 4, 9-11, and 15-17, canceled claims 3, 6-8 and 12-14, and added new claim 18, which is supported by the original claim 6, now cancelled. No new matter has been introduced. Applicants respectfully submit that the amendments have overcome the objections and rejections for the reasons set forth below:

Objections to the Claims

Claims 7-8 and 13-14 are objected to under 37 C.F.R. §1.75 as being a substantial duplicate of claims 10-11 and 16-17.

In response to these objections, claims 7-8 and 13-14 have been canceled.

Double Patenting Rejection

Claims 1-2 and 4-6 are provisionally rejected for nonstatutory obviousness-type double patenting over claims 5-6 and 9-11 of copending Application No. 10/471,087.

Independent claims 1 and 2 have been amended to include limitations recited in original claim 3, which are not disclosed in and distinctively different from Application No. 10/471,087. Applicants respectfully submit that the amendments obviate the ground for the double patenting rejection. Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Claim Rejection under 35 U.S.C. §112 and 35 U.S.C. §101

Claims 10-11 and 16-17 are rejected under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §101 for not setting forth any steps involved in the claimed method/process.

In response to the rejections, claims 10-11 and 16-17 have been amended to recite active and positive steps of the claimed method/process. Applicants respectfully submit that the amendments obviate the grounds for the rejections. Withdrawal of the rejections under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §101 is respectfully requested.

Claim Rejection under 35 U.S.C. §102

Claims 1 and 7-11 are rejected under 35 U.S.C. §102(b) as being anticipated by the '359 patent for reasons stated on page 4 of the Office Action. Claims 1, 3 and 7-11 are rejected under 35 U.S.C. §102(e) as being anticipated by the '573 patent for reasons stated on page 5 of the Office Action. Claims 2, 4, 12 and 15 are rejected under 35 U.S.C. §102(b) as being anticipated by the '539 patent for reasons stated on page 6 of the Office Action. Applicants respectfully traverse the rejection.

For anticipation under 35 U.S.C. §102, the reference "must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." (MPEP §706.02, IV. Distinction between 35 U.S.C. 102 and 103, page 700-21). The Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim (*Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, (Fed. Cir. 1985); *Atlas Powder Co. v. DuPont*, 750 F.2d 1569, (Fed. Cir. 1984); *American Hospital Suppl v. Travenol Labs*, 745 F.2d 1 (Fed. Cir. 1984).

Independent claim 1 of the present invention, as amended, is directed to "an insoluble powder having a negative value of zeta-potential is negative value and a main ingredient of barium sulfate, wherein said insoluble powder has an average primary particle diameter of 3 to 100 μm and an aspect ratio of 3 to 250." (emphasis added).

Independent claim 2 of the present invention, as amended, is directed to an insoluble powder having a negative value of zeta-potential and a main ingredient of

barium sulfate doped with a metal ion, wherein said powder has an average primary particle diameter of 3 to 100 μm and an aspect ratio of 3 to 250." (emphasis added).

The '359 patent generally describes a UV-shielding powder obtained by treating the surface of a powder for cosmetics with a surfactant and an UV-absorbing compound.

The '573 patent generally describes a composite pigment comprising a clay mineral and an aluminum hydroxide that adheres to the surface of the clay mineral.

The '539 patent generally describes a chromium-free aqueous anticorrosive which is suitable for producing thin organic layers on surfaces of steel, metallized steel and aluminum.

None of the cited references discloses an insoluble powder having "an aspect ratio of 3 to 250," as recited in claims 1 and 2 of the instant application. In fact, none of the cited references has ever mentioned the term "aspect ratio." Accordingly, Applicants respectfully submit that claims 1 and 2, as amended, are not anticipated by the '359, '573, and '539 patents because these patents do not teach every aspect of the claimed invention. Applicants further submit that claims 4, 9-11 and 15 are patentable because they depend directly or indirectly from claim 1 or claim 2, and because they recite additional patentable subject matter. Withdrawal of rejections under 35 U.S.C. 102(b) and (e) is respectfully requested. Claims 3, 7-8 and 12 have been canceled. Rejection to these claims are now moot.

Claim Rejection under 35 U.S.C. §103

Claims 1, 3 and 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '573 patent in view of the '652 publication for reasons stated on pages 6-7 of the

Office Action. Applicants respectfully traverse the rejection.

The '573 patent generally describes a composite pigment comprising a clay mineral and an aluminum hydroxide that adheres to the surface of the clay mineral. The '652 publication generally describes a skin cosmetic having excellent skin protecting effects and yet improving effects on chapped skin and moisture retaining ability. Neither reference teaches or suggests or even mentions the term "aspect ratio," let alone a powder having "an aspect ratio of 3 to 250," as recited in the independent claim 1.

Additionally, the combined teachings of the '652 publication and the '573 patent fail to teach or suggest a "negative value of zeta-potential of barium sulfate," which is claimed in the present invention.

It is noted that the '652 publication never teaches or suggests a powder containing "barium sulfate", and the '573 patent never teaches or suggests that a powder containing "barium sulfate" has a "negative value of zeta-potential." Therefore, even if the various clays and minerals taught in the '652 publication can be applied to the powders of the '573 patent, the composition that contains "barium sulfate" and "clay minerals" would have a >30mV absolute value of zeta potential," as suggested by the '652 publication. See Abstract of the '652 publication. Thus, a combined teaching of the '652 publication and the '573 patent would result in a composition which contains a >30mV absolute value of zeta potential, which is different from what is claimed in the independent claim 1.

Furthermore, it is impossible to replace the clay minerals of the '652 publication with the barium sulfate of the '573 patent simply because both are used in cosmetics

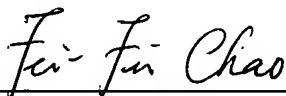
comprising mineral pigments, especially because barium sulfate differs significantly from the swelling clay minerals described in the '652 publication. Therefore, there is no motivation for such replacement.

Accordingly, Applicants respectfully submit that independent claim 1 is patentable over the '573 patent and the '652 publication. Applicants further submit that claims 7-11 are patentable because they depend directly or indirectly from claim 1 and because they recite additional patentable subject matter. Withdrawal of rejections under 35 U.S.C. 103(a) is respectfully requested. Claim 3 has been canceled. Rejection to this claim is now moot.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance and request that a notice of allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

Respectfully submitted,

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